

Remarks

The Office Action mailed May 11, 2004, required an Election/Restriction requirement pursuant under 35 U.S.C. §121 to one of the following inventions:

Group I – claims 1-21 and 25 (classified in class 119, subclass 500); or

Group II -- claims 22-24 (classified in class 119, subclass 436); and

subject to the Election of Group I by the Applicant, the Examiner further subjected the present application to a Restriction/Election of a single species for examination to be selected from a group of eight Examiner identified species.

In compliance with the aforementioned requirements, the Applicant provisionally elects with traverse the claims of Group I (Claims 1-21 and linking claim 25) for prosecution on the merits. The Applicant further elects without traverse the examination of claims directed to Species III: FIGS. 8-10.

Election/Restriction 35 U.S.C. §121

To be fully responsive to the Office Action and to promote an expedited examination of the application, the issues raised by the Restriction/Election Office Action will now be briefly addressed.

The Applicant respectfully points out that independent claim 25 is a proper linking claim drafted under the provisions of 35 U.S.C. §112, sixth paragraph. Claim 25 properly links independent claim 1 with independent claim 22. The Applicant further respectfully points out that under MPEP § 809, sixth paragraph, upon allowance of the linking claim, the non-elected claims must be rejoined and fully examined for patentability if the non-elected claim[s] depend from or include all the limitations of the allowable linking claim. In the present case, claims 22-24 are the non-elected claims.

The Examiner is respectfully reminded that the proper examination of claim 25, requires an identification of the corresponding structure, material, or acts in the specification and equivalents thereof, that carry out the functions recited in the claim, and that 35 U.S.C. §112, sixth paragraph, applies to the Examiner during prosecution of the patent application. *In re Donaldson Company, Inc.*, 16 F.3d 1189 at 1193, 1194 (Fed.Cir.1994)(*en banc*). Pursuant to 35 U.S.C. §112, ¶6, “structure disclosed in the specification is ‘corresponding structure’ only if the specification or prosecution history clearly associates that structure to the function recited in the claim. This duty to link or associate structure to function is the *quid pro quo* for the convenience of employing 112, paragraph 6.” *B. Braun Medical*, 43 USPQ2d 1896 at 1900.

The structure supporting the function called for by the first element of claim 25 expressed as a means clause, "means for facilitating said flow of atmospheric air through the climate conditioning aperture," has been properly identified by the Applicant within the specification beginning at page 11, lines 1-10. While the structure supporting the function called for by the second element of claim 25 expressed as a means clause "means for allowing pivotal movement of the top portion with respect to the base portion in alternate, opposing first and second directions," has been properly identified by the Applicant within the specification beginning at page 11, lines 11-14.

Accordingly, the Examiner is *obliged as a matter of law* to construe the respective first and second "means plus function" elements of claim 25 as the corresponding structure, and equivalents thereof as identified by the Applicant. *In re Donaldson Company, Inc.*, 16 F.3d 1189 at 1195 (Fed.Cir.1994)(*en banc*). See also *Supplemental Examination Guidelines for Determining the Applicability of 35 U.S.C. 112, P6*, 65 FR 38510, Federal Register Vol. 65, No. 120, June 21, 2000; and *Means or Step Plus Function Limitation Under 35 U.S.C. 112, P6*, Notice, 1162 Off. Gaz. Pat. Office 59 (May 17, 1994).

The inclusion of linking claim 25 within the application as filed by the Applicant on September 17, 2003, properly construed by the Examiner, negates the basis for the imposition by the Examiner of a Restriction/Election under 35 U.S.C. §121.

By properly construing the structure supporting the recited function, the restriction of claims 1-21, and 25 to a first invention, and claims 22-24 to a second and separate invention is an improper restriction. Improper because, under 37 CFR §1.141(a) and in accordance with MPEP § 806.05(c), the particulars of linking claim 25 (a subcombination) to show novelty and unobviousness of linking claim 25, are required to show novelty and unobviousness by both independent claims 1 and 22 (each a combination claim relative subcombination claim 25). In the present case, linking claim 25 is a subcombination, because the limitations of linking claim 25 go beyond the limitations of either independent claims 1 and 22, taken separately as a corresponding combination claim.

Therefore, the Applicant respectfully requests that the Examiner withdraw the present Restriction/Election requirement as drawn to the claims of Groups I and II.

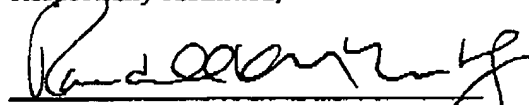
Conclusion

This Response is intended to be a complete response to the Restriction/Election Office Action mailed May 11, 2004.

Should any questions arise concerning this response, the Examiner is invited to contact the below signed Attorney.

Respectfully submitted,

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